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 as Trustee of SORENSEN RESEARCH AND  
 DEVELOPMENT TRUST

UNITED STATES DISTRICT COURT  
 FOR THE SOUTHERN DISTRICT OF CALIFORNIA

JENS ERIK SORENSEN, as Trustee of  
 SORENSEN RESEARCH AND  
 DEVELOPMENT TRUST,

Plaintiff

v.

GLOBAL MACHINERY COMPANY,  
 an Australian company; GMCA PTY.  
 LTD., an Australian company;  
 TRAPONE CORPORATION PTY.  
 LTD., an Australian company; and DOES  
 1 – 100,

Defendants.

) Case No. 08 cv 233 BTM CAB

)  
 ) **MEMORANDUM OF POINTS &**  
 ) **AUTHORITIES IN SUPPORT OF**  
 ) **PLAINTIFF'S MOTION TO MODIFY**  
 ) **PATENT LOCAL RULES SCHEDULE**  
 ) **TO ACCELERATE IDENTIFICATION**  
 ) **OF CLAIMED INVALIDATING PRIOR**  
 ) **ART**

) Date: May 23, 2008

) Time: 11:00 a.m.

) Hon. Barry T. Moskowitz

) **NO ORAL ARGUMENTS UNLESS**  
 ) **ORDERED BY THE COURT**

## INTRODUCTION

Plaintiff Jens Erik Sorensen, as Trustee of Sorensen Research and Development Trust (“Sorensen”) requests the Court pursuant to Patent L.R. 1.3 to accelerate the obligation of all parties claiming invalidity of the subject ‘184 patent to identify prior art that they contend invalidates the patent within 60 days.

The Patent Local Rules set the usual and customary date for service of preliminary invalidity contentions to be approximately four and a half months after filing suit. However, Patent L.R. 1.3 allows the Court to accelerate that and other deadlines when the circumstances warrant a change. Sorensen believes that circumstances warrant an acceleration of this deadline in all of the cases regarding U.S. Patent No. 4,935,184 (the ‘184 patent).

There are currently 24 patent infringement cases pending in this Court regarding the ‘184 patent<sup>1</sup>. In each case where an answer has been filed, the Defendants have asserted invalidity of the patent (and in some instances cross-complained for declaratory relief of invalidity) without identification of any factual basis for that claim. Many have also requested a stay pending conclusion of two

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<sup>1</sup> *Sorensen v. DMS Holdings, et al*, Case No. 08cv559, filed March 25, 2008; *Sorensen v. Kyocera International, Inc., et al.*, Case No. 08cv411; *Sorensen v. Central Purchasing, LLC, et al.*, Case No. 08cv309; *Sorensen v. Logitech, Inc., et al.*, Case No. 08cv308; *Sorensen v. Metabo Corporation, et al.*, Case No. 08cv304; *Sorensen v. Rally Manufacturing, Inc., et al.*, Case No. 08cv302; *Sorensen v. Sunbeam Products, Inc., et al.*, Case No. 08cv306; *Sorensen v. Star Asia, U.S.A., LLC, et al.*, Case No. 08cv307; *Sorensen v. CTT Tools, Inc., et al.*, Case No. 08cv231; *Sorensen v. Global Machinery Company, et al.*, Case No. 08cv233; *Sorensen v. Emissive Energy Corp., et al.*, Case No. 08cv234; *Sorensen v. Alltrade Tools, LLC, et al.*, Case No. 08cv232; *Sorensen v. Motorola, Inc., et al.*, Case No. 08cv0136; *Sorensen v. Sanyo North America Corporation, et al.*, Case No. 08cv0135; *Sorensen v. Informatics, Inc., et al.*, Case No. 08cv0134; *Sorensen v. Ryobi Technologies, Inc., et al.*, Case No. 08cv0070; *Sorensen v. Senco Products, Inc.*, Case No. 08cv0071; *Sorensen v. Emerson Electric Co., et al*, Case No. 08cv0060; *Sorensen v. Johnson Level & Tool Mfg. Co., Inc.*, Case No. 08cv0025; *Sorensen v. Energizer Holdings, Inc., et al*, Case No. 07cv2321; *Sorensen v. Giant International, Inc., et al*, Case No. 07cv2121; *Sorensen v. Esseplast (USA) NC, Inc., et al*, Case No. 07cv2277; *Sorensen v. Helen of Troy Texas Corporation, et al*, Case No. 07cv2278; *Sorensen v. The Black & Decker Corporation, et al*, Civil Case No.: 06cv1572.

1 reexaminations of the '184 patent currently pending before the USPTO.

2 In the order staying the low-number related case, *Sorensen v. Black & Decker*  
3 *Corporation, et al*, Case No. 06cv01572, this Court explained the rationale for a stay  
4 pending reexamination in part as follows:

5 The Court believes that it will benefit from the PTO's evaluation of how  
6 the previously unconsidered prior art references impact the claims of the  
7 patent-in-suit.

8 *Id.*, at Docket #243, page 8:28-9:1 ("*Black & Decker Stay Order*"). In the Order, the  
9 Court also cited a list of advantages to stay pending reexamination from *Broadcast*  
10 *Innovation, L.L.C. v. Charter Communications, Inc.*, No. 03-cv-2223-ABJ-BNB,  
11 2006 U.S. Dist. LEXIS 45523, at \*26-31 (D.Colo. July 11, 2006), including:

12 Shifting the patent validity issue to the PTO has many advantages,  
13 including:

14 1. All prior art presented to the Court will have been first considered by  
15 the PTO, with its particular expertise . . . .

16 *Black & Decker Stay Order*, Docket #243, page 8:15-17 (emphasis added).

17 In order to achieve the benefits that the Court intended to be gained from a  
18 stay pending reexamination, it is necessary for the sued parties that are asserting  
19 invalidity of the '184 patent to identify claimed invalidating prior art in sufficient  
20 time for that prior art to be provided to the USPTO and considered during the already  
21 pending reexamination proceedings.

22 Thus, Sorensen requests the Court to order the Defendants to disclose their  
23 claimed invalidating prior art within 60 days.

## 24 **FACTUAL SUMMARY**

25 This patent infringement suit was filed on February 5, 2008 (Docket #1). The  
26 Complaint has not yet been answered. In July 2007 and December 2007,  
27 respectively, defendants in the related Black & Decker case filed requests for *ex*  
28

1 *parte* reexamination of the ‘184 patent with the USPTO. *Kramer Decl.* ¶ 4 and  
2 Exhibits A and B thereto. The prior art cited in the second *ex parte* request  
3 contained several prior art references that had not been disclosed to Sorensen in  
4 either of the parties’ Preliminary Invalidity Contentions served on February 2, 2007,  
5 nor the Amended Preliminary Invalidity Contentions served on March 5, 2007, nor  
6 the first *ex parte* request. *Kramer Decl.* ¶ 5 and Exhibits C and D thereto.

7 In the course of the present reexamination proceedings, Sorensen has, to their  
8 knowledge, identified to the USPTO all claimed invalidating prior art identified to  
9 Sorensen to date from any source. *Kramer Decl.* ¶ 6.

10 Although Sorensen has been in contact with one of more of the Defendants in  
11 this case regarding the ‘184 patent since September 2004, none of the  
12 correspondence between the parties in this case has ever included any identification  
13 of any prior art or other basis for invalidity of the ‘184 patent. Thus, Sorensen has  
14 been unable to ensure that these Defendants’ asserted prior art will be reviewed by  
15 the USPTO. *Kramer Decl.* ¶ 7.

## 16 17 **ARGUMENT**

### 18 19 **I. THIS COURT HAS THE POWER TO ACCELERATE DEADLINES SET** 20 **FORTH IN THE LOCAL PATENT RULES, INCLUDING THE DEADLINE** 21 **FOR PRELIMINARY INVALIDITY CONTENTIONS.**

22 “The court may accelerate, extend, eliminate, or modify the obligations or  
23 deadlines set forth in these Patent Local Rules based on the court’s schedule or the  
24 circumstances of any particular case, including, without limitation, the complexity of  
25 the case or the number of patents, claims, products, or parties involved. . . .” Patent  
26 L.R. 1.3.

27 The Patent L.R. set the deadline for parties opposing a claim of patent  
28 infringement to serve Preliminary Invalidity Contentions not later than 60 days after  
service of Preliminary Infringement Contentions upon them. Patent L.R. 3.3, *et seq.*

1 The circumstances of this case, along with the 23 other pending ‘184 patent  
 2 cases, warrants acceleration of the deadline to disclose any asserted invalidating  
 3 prior art in time for those pieces of prior art to be reviewed by the USPTO within the  
 4 currently pending reexamination proceedings.

5  
 6 **II. ACCELERATION OF THE DEADLINE TO DISCLOSE CLAIMED**  
 7 **INVALIDATING PRIOR ART WILL ALLOW CONCURRENT REVIEW**  
 8 **OF ALL SUCH PRIOR ART BEFORE THE USPTO AND CONSERVE**  
 9 **RESOURCES.**

10 Pursuant to 35 U.S.C. § 302, requests for reexamination of a patent may be  
 11 filed by “any person at any time . . . on the basis of any prior art cited under the  
 12 provisions of section 301 [patents or printed publications which that person believes  
 13 to have a bearing on the patentability of any claim of a particular patent] . . .”

14 The intent of having a reexamination process is to allow for a cost effective  
 15 alternative to litigation regarding the validity of a patent. That goal is largely lost  
 16 when parties file successive reexamination requests (as has already been done with  
 17 the ‘184 patent) and is entirely lost if pending reexaminations can and will be  
 18 followed by successive judicial or USPTO validity challenges. This problems  
 19 inherent in successive reexaminations was already noted by the USPTO in 2004. In  
 20 explanation of certain rule changes, the USPTO stated:

21 It has been the Office’s experience, however, that both patent owners  
 22 and third party requesters have used a second or subsequent  
 23 reexamination request . . . to prolong the reexamination proceeding . . . .  
 24 These actions by patent owners and third party requesters have resulted  
 25 in multiple reexaminations taking years to conclude, thus making it  
 26 extremely difficult for the Office to conclude reexamination  
 27 proceedings with “special dispatch” as required by statute (35 U.S.C.  
 28 305 for ex parte reexamination, 35 U.S.C. 314 inter partes  
 reexamination).

See *Kramer Decl.* ¶ 8, Exhibit E thereto in the “Background” section.

1 In the *Black & Decker* case, the case had proceeded for almost a full year prior  
2 to the filing of the first reexamination request (see Case No. 06cv1572, Docket #1 vs.  
3 Docket #178). Yet, despite two productions of preliminary invalidity contentions,  
4 the defendants did not cite all of the prior art that was cited in a second  
5 reexamination request.

6 Neither the Court nor Sorensen, and more importantly, the USPTO currently  
7 conducting a reexamination of the '184 patent, know what prior art these Defendants  
8 assert may be used as a basis to invalidate the '184 patent.

9 Unless the parties making a blanket claim of invalidity are required to  
10 promptly identify all prior art that they believe might invalidate the '184 patent, the  
11 stay-pending-reexamination benefit of "all prior art presented to the Court [having  
12 been] first considered by the PTO" as set forth by the courts in *Emhart Indus., Inc. v.*  
13 *Sankyo Seiki Mfg. Co.*, 3 U.S.P.Q.2d 1889, 1890 (N.D. Ill. 1987); *Broadcast*, *supra*;  
14 and this Court in the *Black & Decker* case, will be lost.

## 15 16 CONCLUSION

17 Judicial efficiency will be greatly enhanced by acceleration of the deadline for  
18 the Defendants in this case (and in all of the related '184 patent cases) to identify all  
19 items of claimed invalidating prior art within the next 60 days. This would allow  
20 Sorensen to advise the USPTO of all prior art asserted to be invalidating  
21 immediately. The USPTO could then consider the prior art within the currently  
22 pending reexamination proceedings. This consolidation of efforts into the currently  
23 pending reexaminations will reduce the likelihood of any further substantial delays  
24 on the issue of patent validity after the pending reexamination proceedings are  
25 concluded.

26 Sorensen thus respectfully requests the Court to order the Defendants in this  
27 case to identify to Sorensen all items of claimed invalidating prior art within 60 days.  
28

1 RESPECTFULLY SUBMITTED this 26<sup>th</sup> day of March, 2008.

2  
3 JENS ERIK SORENSEN, as Trustee of  
4 SORENSEN RESEARCH AND DEVELOPMENT  
TRUST, Plaintiff

5  
6 /s/ Melody A. Kramer

Melody A. Kramer, Esq.

7 J. Michael Kaler, Esq.

8 Attorneys for Plaintiff